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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,712	12/05/2001	Kazuo Hiraguchi	Q67023	7134

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EXAMINER

BUI, LUAN KIM

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/16/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,712

Applicant(s)

HIRAGUCHI ET AL.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Weisburn et al. (5,597,068; hereinafter Weisburn'068). Weisburn'068 discloses a storage case (1) comprising a storage part (2), a cover part (10) including outer walls and a hinge part (11) for connecting together the storage part and the cover part in an openable and closable manner. The storage part is dimensioned to receive a jewel box (70). Weisburn'068 further discloses one or more ribs (40-47) with each having a U-shaped section disposed on the hinge part (Figures 1-8). The storage part of Weisburn'068 is inherently capable of holding a magnetic tape cassette and the ribs of Weisburn'068 are inherently capable of storing a sheet bundle therein. Regarding the intended use of the claimed invention for storing a magnetic tape cassette or capable of storing a sheet bundle, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,597,068; hereinafter Weisburn'068). Weisburn'068 discloses a storage case (1) comprising a storage part (2), a cover part (10) including outer walls and a hinge part (11) for connecting together the storage part and the cover part in an openable and closable manner. The storage part is dimensioned to receive a jewel box (70). Weisburn'068 further discloses one or more ribs (40-47) with each having a U-shaped section disposed on the hinge part (Figures-1-8). The ribs of Weisburn'068 are capable of storing a sheet bundle therein. Weisburn'068 discloses in the embodiment of Figure 7 that the clearance between the outer top surface of the jewel box and the bottom surface of the holder (55) is about the same thickness of the jewel box and since the thickness of the jewel box is about the same thickness of the magnetic tape cassette. Therefore, there will be clearance between the cover part and the magnetic tape cassette. To the extent that Weisburn'068 fails to show a clearance when the storage case is adapted for holding the magnetic tape cassette, it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Weisburn'068 to modify the storage case so the hinge part is made bigger having one or more ribs thereon to prevent the ribs from contacting the magnetic tape cassette.

Weisburn'068 fails to show the ribs comprise a pair of ribs as recited in claims 12-15 and 17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ribs of Weisburn'068 so the ribs comprises a pair of ribs each having

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two parallel flat plates having mutually opposed, convexly curved surfaces or the rib having a rectangular section and disposed substantially over the entire areas of the hinge part because the selection of the specific shape for the ribs such as the one as claimed would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well and inasmuch as applicant's specification does not state that using these specific shapes as claimed solves any particular problem or yields any unexpected results.

Allowable Subject Matter

5. Claims 1-8 are allowed.

Response to Arguments

Applicant's arguments with respect to 9/29/2003 have been considered but are deemed to be moot in view of the new grounds of rejection.

In response to applicant's argument that for storing a magnetic tape cassette or capable of storing a sheet bundle, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3580 or (703) 872-9302 for Formal papers and (703) 872-9303 for After Final communications.

lkb
October 13, 2003



Luan K. Bui
Primary Examiner